

Appl. No. 09/988,691
Amdt. dated October 11, 2005
Reply to Office action of July 12, 2005

REMARKS/ARGUMENTS

Applicant has received the Office Action dated July 12, 2005, in which the Examiner: 1) rejected claims 1-7, 11-22, 24, and 36 under 35 U.S.C. § 103(a) as allegedly unpatentable over *Donnelly et al.* (U.S. Pat. No. 5,945,862, hereinafter *Donnelly*) in view of *Gaudet* (U.S. Pat. No. 6,094,082, hereinafter *Gaudet*); and 2) rejected claims 25-35 under 35 U.S.C. § 102(b) as allegedly anticipated by *Gaudet*. With this Response, Applicant has amended claim 24.¹ Therefore, claims 1-7, 11-22, and 24-36 remain pending.

I. THE § 103 REJECTIONS

Claims 1-7, 11-22, 24, and 36 presently stand rejected as allegedly obvious over *Donnelly* in view of *Gaudet*. Applicant respectfully traverses these rejections and submits that a *prima facie* case of obviousness has not been established.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2143.

A. The Cited Art Fails To Teach Or Suggest All Of The Claim Elements

Independent claim 1 requires "a first comparator and a second comparator, and wherein said first comparator receives said binary output signal from said digital counter, and in response generates multiple threshold values." The Office Action at 3, ¶ 2 admits that *Donnelly* fails to teach or suggest these claim elements yet suggests that *Gaudet* teaches these claim elements. Applicant respectfully disagrees because the "comparators" of *Gaudet*, such as

¹ Claim 24 has been amended to correct a clerical mistake that occurred when claim 23 was canceled. Thus, this amendment is not made for any reason related to the patentability of claim 24 and should not be construed as a narrowing amendment or as a relinquishment of claim scope.

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comparator 16, comparator 34, and phase comparator 110, do not perform the recited features of claim 1. More particularly, none of these "comparators" generate multiple threshold values for the binary output signal from binary counter 116 (shown in Figure 7 of *Gaudet*). For at least this reason, the *prima facie* case of obviousness is not met with respect to independent claim 1 and its dependent claims.

Independent claim 19 requires (emphasis added):

generating a binary count value signal, indicative of the count value in the binary counter, on a first plurality of output signal lines; converting the binary count value on said first plurality of output signal lines to a thermometer-coded signal on a second plurality of output signal lines; and enabling a delay line with said thermometer-coded signal to control the delay of said clocked signal; wherein converting the binary count value includes establishing a plurality of threshold values corresponding to said binary count value signal.

Again, the "comparators" (16, 34, and 110) of *Gaudet* do not perform the recited features of claim 19 because none of these "comparators" establish a plurality of threshold values corresponding to the binary count value signal coming from binary counter 116. For at least this reason, the *prima facie* case of obviousness is not met with respect to independent claim 19 and its dependent claims.

B. *Gaudet* Teaches Against Using Comparators

In fact, in contradistinction to teaching or suggesting, *Gaudet* teaches against the use of comparators. Specifically, *Gaudet* column 6, line 62 through column 7, line 2, notes that quantizing phase error with comparators results in a solution that "is not robust over PVT [process, voltage, and temperature]." Instead of comparators, *Gaudet* teaches the use of phase interpolators. See col. 7, ll. 7 *et seq.* Thus, one of ordinary skill in the art would not be motivated to combine *Donnelly* with *Gaudet* to arrive at the elements of claims 1 and 19. For at this additional reason, a *prima facie* case of obviousness is not met with regard to independent claims 1 and 19, as well as their dependent claims.

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II. THE § 102 REJECTIONS

In order for a reference to anticipate a claim, "[t]he identical invention must be shown [in the anticipatory reference] in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Additionally, the elements of the allegedly anticipatory reference must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Claims 25-35 presently stand rejected as allegedly anticipated under § 102(b) by *Gaudet*. Applicant respectfully traverses these rejections because *Gaudet* fails to teach or suggest all of the claim elements.

Independent claim 25 recites (emphasis added):

a binary counter that produces a binary output signal that indicates a desired delay for said clocked signal based on a count value produced in response to said output signal from said phase detector;
comparator logic that establishes threshold values for said binary output signal, and which generates a plurality of enable output signals based on said threshold values...

The "comparators" of *Gaudet*, however, such as comparator 16, comparator 34, and phase comparator 110 do not perform the recited features of claim 25. That is, none of these "comparators" establish a threshold value for the binary output signal from binary counter 116 (shown in Figure 7 of *Gaudet*). For at least this reason, independent claim 25 and its dependent claims are not anticipated by *Gaudet*.

III. CONCLUSION

In the course of the foregoing discussions, Applicant may have at times referred to claim elements in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other elements can be ignored or dismissed. The claims must be viewed as a whole, and each element of the claims must be considered when determining the patentability of the claims.

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Applicant respectfully requests reconsideration and that a timely Notice of Allowance be issued in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,



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